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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,871

02/04/2004

Joseph W. Pieczynski II

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43963

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04/15/2008

ZIMMER TECHNOLOGY - BAKER & DANIELS  
111 EAST WAYNE STREET, SUITE 800  
FORT WAYNE, IN 46802

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,871	<b>Applicant(s)</b> PIECZYNSKI ET AL.	
	<b>Examiner</b> Nicholas Woodall	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 01/14/2008.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 34-45 is withdrawn in view of a new interpretation of the reference(s) to Mumme (U.S. Patent 5,423,827). Rejections based on the cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 34-37 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Mumme (U.S. Patent 5,423,827).

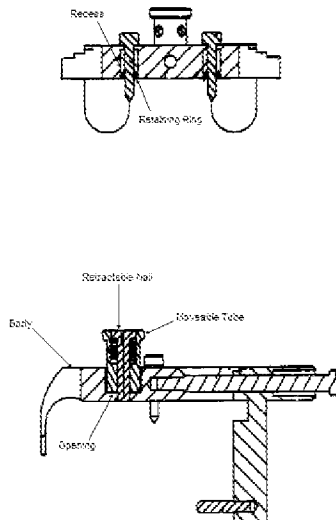
Regarding claim 34, Mumme discloses a device comprising a body, a moveable tube, and a retractable nail (see Figure 1 below). The body includes a bottom surface and an opening. The moveable tube is positioned in the body. The retractable nail includes a shoulder, wherein the retractable nail is at least partially positioned within the tube and is capable of being urged such that an end of the nail extends beyond the bottom surface of the body. Regarding claim 35, Mumme discloses a device further comprising a retaining ring positioned in a recess formed in the body adjacent the bottom surface of the body capable of engaging the bottom surface of the retractable nail shoulder. Regarding claim 36, Mumme discloses a device wherein the tube

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includes an internal shoulder capable of engaging an upper surface of the retractable nail shoulder. Regarding claim 37, Mumme discloses a device wherein the tube has an external shoulder that is capable of engaging an internal shoulder of the opening.

Regarding claim 41, Mumme discloses a device comprising a body, a moveable tube, and a retractable nail. The body includes a bottom surface and an opening formed in the body. The opening includes an internal shoulder. The moveable tube is positioned in the opening. The moveable tube includes an internal shoulder and an external shoulder. The retractable nail is at least partially positioned within the tube. The retractable nail includes a shoulder with a top surface and a bottom surface, wherein the retractable nail is capable of being urged such that an end of the nail extends beyond the bottom surface of the body, the top surface of the shoulder is capable of engaging the internal shoulder of the tube, and wherein the external shoulder on the tube is capable of engaging the internal shoulder of the opening. Regarding claim 42, Mumme discloses a device further comprising a retaining ring positioned in a recess formed in the body adjacent the bottom surface of the body, wherein the ring is capable of engaging the bottom surface of the retractable nail shoulder.

Figure 1



### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 38-40 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mumme (U.S. Patent 5,423,827).

Regarding claims 38 and 43, Mumme discloses a device comprising a drill guide (106 and 108) coupled to the body and capable of being positioned within the body.

Regarding claims 39 and 44, Mumme discloses a device wherein the drill guide is capable of providing a guide for a femur post hole to be formed in a femur. Regarding

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claims 40 and 45, Mumme discloses a device wherein the drill guide is capable of being positioned on a moveable body (102) positioned in a recess (82) formed in a top surface of the body. Regarding claims 38-40 and 43-45, Mumme discloses the invention as claimed except for the device comprising a plurality of drill guides. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Mumme comprising a plurality of drill guides, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733